

Remarks

The Examiner appears to indicate in paragraph 2 of the outstanding office action that the proposed drawing correction has been accepted and is also unaccepted. Applicant respectfully requests clarification.

The Examiner rejected claims 1-4, 7, 18-20, and 27 under 35 U.S.C. §103 as being unpatentable in view of U.S. Patent 1,724,349 ("Haag") over U.S. Patent 6,691,432 ("Masseron"). The Examiner also rejected claims 1, 7, 18, and 27-28 as being unpatentable over U.S. Patent 1,171,122 ("Schaff") in view of Masseron. The Examiner also rejected dependent claims, which should all be allowable if the foregoing amendments and following remarks to the independent claims put the independent claims in condition for allowance.

For a combination of references to be properly made under 35 U.S.C. §103, there must be some teaching or suggestion in the references to make the combination. Applicant submits that there is no teaching or suggestion to combine Masseron with either Haag or Schaff and, therefore, the rejections under 35 U.S.C. §103 should be withdrawn.

Masseron relates to an outsole having a well 14 and a dome 21 that is placed within the well 14. Masseron makes no mention of a watertight seal, nevermind a perimeter of the opening being commensurate with a perimeter of the opening. Masseron does not disclose, teach, or suggest a perimeter of the opening to be commensurate with a perimeter of the plug for providing a watertight seal. In fact, Masseron teaches the dome 21 to move relative to the well 14 in the outsole, as shown in figures 91, 9b, and 9c. This movement is described in col. 5, line 62-col. 6, line 10 as being desired for enhancing cushioning to a user. Because dome 21 is moving relative

to well 14, there cannot be a watertight seal between the plug and the opening, as required in all of Applicant's claims. Applicant submits a watertight seal cannot exist when the plug is moving relative to the opening absent a gasket or other sealing device. Hence, Masseron teaches away from Applicant's invention.

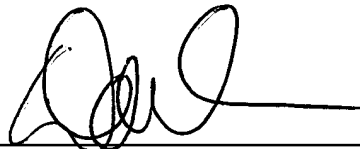
Both Haag and Schaff also do not relate to a watertight seal between a perimeter of the opening and a perimeter of the plug because a watertight seal would not be necessary since both Haag and Schaff do not have an opening in the outsole that extends from the inner surface of the outsole to the outer surface of the outsole, where the outer surface is adapted to be in contact with the walking surface. Since there is no opening that extends from the inner surface to the outer surface of Haag and Schaff, there is no reason to have a plug with a watertight seal with the opening in the outsole. Therefore, there is no teaching or suggestion to combine Haag or Schaff with any reference that discloses a perimeter of the opening being commensurate with a perimeter of the plug for providing a watertight seal. Hence, even assuming Masseron is being used to show a perimeter of the opening to be commensurate with a perimeter of the plug for providing a watertight seal, there is no teaching or suggestion to combine Masseron with either Haag or Schaff because one skilled in the art would not think to combine Haag or Schaff, references that relate to an outsole without a hole and without a need for a watertight seal, with Masseron.

Even if the combination were made, no matter how improper, one skilled in the art would still not arrive at Applicant's claimed invention without modifying the combination. A combination of Masseron with Haag or Schaff may result in an outsole having a through hole with a dome placed inside and moving relative to the through hole. Another combination may result in an outsole having a hole that goes partially through the outsole and a dome placed in the partial hole for compressing trapped air. The combination would need to be further modified to prevent movement between the

dome and well and also be modified to have a perimeter of the opening be commensurate with a perimeter of the plug. Such modifications can hardly be argued to be inconsequential.

Because Applicant's invention requires a perimeter of the opening to be commensurate with a perimeter of the plug for providing a watertight seal, and because Masseron teaches away from such a watertight fit, Applicant respectfully submits that all claims are in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'David Chen', written over a horizontal line.

David Chen, Registration No. 46,613
Gene S. Winter, Registration No. 28,352
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street; Stamford, CT 06905-5619
203 324-6155